REMARKS

Applicants appreciate the Office Action of December 17, 2004. Applicants have amended Claims 10 through 17 to recite a "computer program product" and, therefore, submit that Claims 10 through 17 are in compliance with 35 U.S.C. § 101. Furthermore, Applicants have canceled Claims 24 and 26-28 from the present application and added new Claims 29-31. Applicants respectfully submit that the pending claims are patentable over the cited references for at least the reasons discussed below. Accordingly, Applicants respectfully submit that the pending claims are in condition for allowance, which is respectfully requested in due course.

Independent Claims 1, 10, 18 and 19 are Patentable Over the Cited Reference

Claims 1-3, 7-11, 14-16, 18-20, 24-26 and 28 are rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent No. 6,728,877 to Mackin *et al.* (hereinafter "Mackin"). Applicants respectfully submit that many of the recitations of these claims are neither disclosed nor suggested by Mackin. For example, Amended Claim 1 recites:

> A method of migrating configuration data from a first executable product to a second executable product, the method comprising:
> instructing, **from an external agent**, the first executable product to provide a file containing selected configuration data; and
> producing, by the first executable product, the file containing the selected configuration data in a format acceptable to the second executable product.

Independent Claims 10, 18 and 19 contain similar recitations to the highlighted recitations. Applicants submit that at least the highlighted portions of Amended Claim 1 are neither disclosed nor suggested by the cited combination.

Claim 1 has been amended to incorporate the recitations of dependent Claim 3, namely, "the external agent." The Office Action states, with respect to Claim 3, that Mackin teaches this recitation at column 8, lines 9-12. The cited portion of Mackin states:

> An OLE or ActiveX control is an object that accepts and responds to events, such a selection by a mouse or a key on a keyboard, or a selection by another object-oriented member function.

See Mackin, column 8, lines 9-12. In other words, Mackin may use OLE to implement some portion of the system discussed in Mackin. In other words, the system discussed in Mackin may

interact with a user interface, for example, a keyboard or mouse. In contrast, Claim 1 recites "instructing, **from an external agent**, the first executable product to provide a file containing selected configuration data." Nothing in Mackin discloses or suggests that the instruction to create the file comes from an external agent. In fact, Mackin specifically recites throughout the specification that the system "**automatically**" transitions configuration settings from a source (old) computing system to a target (new) computing system. *See e.g.*, Mackin, column 4, lines 15-17: *see also*, Mackin, Title; Abstract; column 2, lines 46-55; and column 7, lines 12-14. Thus, Mackin specifically teaches away from waiting for an instruction from an external agent before creating the file containing the configuration data as recited in Amended Claim 1.

Accordingly, Independent Claims 1, 10, 18 and 19 are patentable over Mackin for at least the reasons discussed above. Furthermore, the dependent claims are patentable at least per the patentability of the independent base claims from which they depend.

Many of the Dependent Claims are Separately Patentable

Claims 2-3, 7-9, 11, 14-16 and 20 are rejected under 35 U.S.C. § 102(e) as being anticipated by Mackin *et al.* Claims 12, 13 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mackin in view of United States Patent No. 5,969,704 to Green *et al.* (hereinafter "Green"). Claims 4, 6, 21, 22 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mackin in view of United States Patent No. 6,757,720 to Weschler (hereinafter "Weschler"). Claims 5 and 23 stand rejected as being unpatentable over Mackin in view of Weschler and in further view of obviousness. As discussed above, the dependent claims are patentable at least per the patentability of the independent base claims from which they depend. Many of the dependent claims are also separately patentable.

As a preliminary note, the Office Action makes many statements that imply that certain aspects of the present invention are "inherent" or "common practice." *See e.g.*, Office Action, page 3, paragraph 5. Applicants would like to point out that Applicants disagree with the assertion in the Office Action that these aspects are inherent or commonplace even if not specifically addressed herein.

Claim 3 recites:

> The method of migrating configuration data according to Claim 1, further

comprising:

modifying the first executable product to respond to a command by **the external agent** to provide the selected configuration data in the format acceptable to the second executable product.

As discussed above with respect to Claim 1, nothing in Mackin discloses or suggests receipt of a command from an external agent as recited in, for example, Claim 1. Accordingly, it follows that nothing in Mackin discloses or suggests modifying the first executable product to respond to the command. Accordingly, Claim 3 is separately patentable for at least these additional reasons.

Claims 12, 13 and 17 recite wherein the external agent is a scripted command issued through execution of a batch file, wherein the external agent is a system scheduler that issues the command at a pre-determined time and wherein the internal control blocks were constructed using configuration files and command line parameters, respectively. The Office Action admits that Mackin fails to explicitly teach the aspects of the present invention as claimed in Claims 12, 13 and 17. *See* Office Action, pages 7 and 8. However, the Office Action states that Green provides the missing teachings.

Applicants respectfully submit there is no motivation or suggestion to combine the cited references as suggested in the Office Action. As affirmed by the Court of Appeals for the Federal Circuit in *In re Sang-su Lee*, a factual question of motivation is material to patentability, **and cannot be resolved on subjective belief and unknown authority**. *See In re Sang-su Lee*, 277 F.3d 1338 (Fed. Cir. 2002). It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983).

The Office Action states:

> Mackin and Green are analogous art because they are both concerned with the same field of endeavor, namely executable software on a computer apparatus. Therefore, it would have been obvious to someone of ordinary skill in the art, at the time the invention was made, to implement a batch file to perform Mackin's method wherein, the external agent is a scripted command issued through execution of a batch file. The motivation to do so was taught by Mackin's disclosure of the transition application programmers interface or (API), (Column 6, lines 38-51). Mackin further teaches scripted files and file system I/O, which also implies batch files (Column 8, lines 9-12). Thus, it would have been obvious to a person of skill in the art, to implement a scripted

command by execution of a batch file.

See Office Action, page 7. This motivation is a motivation based on "subjective belief and unknown authority", the type of motivation that was rejected by the Federal Circuit in *In re Sang-su Lee*. In other words, the Office Action does not point to any specific portion of the cited references that would induce one of skill in the art to combine the cited references as suggested in the Office Action. If the motivation provided in the Office Action is adequate to sustain the Office's burden of motivation, then anything that is "in the same field of endeavor" would render a combination obvious. This cannot be the case. Accordingly, the statement in the Office Action with respect to motivation does not adequately address the issue of motivation to combine as discussed in *In re Sang-su Lee*. Thus, it appears that the Office Action gains its alleged impetus or suggestion to combine the cited references by hindsight reasoning informed by Applicants' disclosure, which, as noted above, is an inappropriate basis for combining references.

Furthermore, Mackin discusses a *Method and System for Automatically Transitioning of Configuration Settings Among Computer Systems* as recited in the title. Green, on the other hand, discusses a *Configurable LED Matrix Display* as recited in the title. Nothing in the cited references or the art itself would motivate a person of skill in the art to combine the configuration settings system of Mackin with the display of Green. Accordingly, Applicants respectfully submit that dependent Claims 12, 13 and 17 are separately patentable over the cited combination for at least these additional reasons.

The Office Action admits that Mackin fails to explicitly teach the aspects of the present invention as claimed in Claims 4, 6, 21 and 22. *See* Office Action, pages 8-10. The Office Action further admits that Mackin and Weschler both fail to explicitly teach the aspects of the present invention as claimed in Claims 5 and 23. *See* Office Action, page 10. The Office Action offers the same types of motivations with respect to the combination of Mackin and Weschler as it does with respect to Mackin and Green. As discussed above, these types of motivations based on "subjective belief and unknown authority", are the types of motivations that were rejected by the Federal Circuit in *In re Sang-su Lee*. For example, if the motivation provided in the Office Action is adequate to sustain the Office's burden of motivation, then anything that would "enhance, override or overload basic functionality and behavior of an existing program" would

render a combination obvious. *See* Office Action, page 9. This cannot be the case. Accordingly, the statement in the Office Action with respect to motivation does not adequately address the issue of motivation to combine as discussed in *In re Sang-su Lee*. Thus, it appears that the Office Action gains its alleged impetus or suggestion to combine the cited references by hindsight reasoning informed by Applicants' disclosure, which, as noted above, is an inappropriate basis for combining references. Accordingly, dependent Claims 4, 5, 6, 21, 22 and 23 are separately patentable over the cited references for at least these additional reasons.

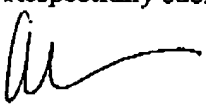
The New Claims are Patentable

New Claims 29 through 31 are patentable over the cited references as none of the cited references appear to disclose or suggest the first executable product being OROUTED and the second executable product being OMPROUTE.

CONCLUSION

Applicants respectfully submit that the pending claims are in condition for allowance, which is respectfully requested in due course. It is not believed that any extension of time is required for this paper. However, in the event that an extension of time is necessary to allow consideration of this paper, such an extension is hereby petitioned under 37 C.F.R. §1.136(a). Any additional fees believed to be due in connection with this paper may be charged to our Deposit Account No. 09-0461.

Respectfully submitted,



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